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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,380	12/20/2000	Hassan Jomaa	12964.18	2374

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EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/09/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/720,380

Applicant(s)

Jomaa

Examiner

S. Mark Clardy

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 24, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) 4, 5, 9-16, 18-20, 22, and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 17, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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Claims 1-23 are pending in this application which has been filed under 35 USC 371 as a national stage application of PCT/EP99/04260, filed June 23, 1999. This application lacks unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)). Restriction has been required under 35 U.S.C. 121 and 372.

This application contains the inventions or groups of inventions as enumerated in the previous office actions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. The elected invention comprises the following Groups:

Group I, claim(s) 1-2, drawn to compositions comprising:

- A. an anti-infectious active agent that inhibits the 2C-methylerythrose-4-metabolic pathway
- B. a lipid metabolism inhibitor

Group VI (and IX), wherein A is a phosphorus (and oxazole) containing compound

Group II, wherein B is a squalene synthase inhibitor

Group XII, drawn to uses of lipid metabolism inhibitors as herbicides.

Applicant has further elected the species comprising the following active agents:

A. Alendronate¹: $\text{HO} - \text{C}(\text{PO}_3\text{H}_2)_2 - (\text{CH}_2)_3 - \text{NH}_2$

B. Fosmidomycin²:

$$\begin{array}{c} \text{O} \\ \parallel \\ \text{O} = \text{CH} - \text{N} - (\text{CH}_2)_3 - \text{P} - \text{OH} \\ | \qquad \qquad | \\ \text{OH} \qquad \qquad \text{OH} \end{array}$$

¹ Alendronic acid: 4-amino-1-hydroxybutylidene-1,1-bisphosphonic acid

² 3-(N-formyl-N-hydroxyamino)propylphosphonic acid

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Again, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 4, 5, 9-16, 18-20, 22, and 23 have been held withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4 and 7.

Note that several of these withdrawn claims will be subject to the same rejections below should the elected species be found allowable, and other claims be subject to examination.

Claims 1-3, 6-8, 17, and 21 have been examined below.

Claim 21 provides for the use of lipid metabolism inhibitors, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 21 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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Claims 3, 4, 6, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 3, 4, and 6 recite broad recitations, followed by a narrower statement of the range/limitation beginning with the phrase "in particular".

Claim 21 is indefinite in that it is a "use" claim without a single method step.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3, 6-8, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U Sheffield (PCT WO 97/43437), Teijin Ltd (JP 61-106504, and JPO Abstract), and Kamuro et al (US 4,846,872).

U Sheffield teaches that inhibitors of lipid metabolism, specifically prenyl transferase (farnesyl pyrophosphate synthase) and isopentenylpyrophosphate isomerase (IPI) inhibitors (p. 18, lines 15-25) such as alendronate (p. 29, lines 1-3; p. 43, "Methods") are useful as fungicides and herbicides (p. 17, lines 4-11; p. 26, line 26 through p. 27, line 3; claim 14). Thus applicants' elected "A" component was a known herbicidal agent.

Teijin Ltd teaches that fosmidomycin was also a known herbicidal agent (Abstract and structures on p. 39).

Kamuro et al teach that it was also known to combine fosmidomycin with additional herbicidal agents (col 2, lines 50-53), specifically ametryn and diuron (abstract; column 1, lines 5-41).

One of ordinary skill in the art would be motivated to combine these references because they disclose the herbicidal utility of the elected compounds.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined alendronate and fosmidomycin because they are known herbicidal agents. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069.

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No data has been provided in the specification to demonstrate any unexpected herbicidal characteristics of the elected composition.

No unobvious or unexpected results are noted; no claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.

A handwritten signature in black ink, appearing to read "S. Mark Clardy", with a stylized, flowing script.

S. Mark Clardy
Primary Examiner
AU 1616

September 5, 2012